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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,063	11/24/2003	David W. Nelson	36729-198472	9139
26694	7590	09/12/2006	EXAMINER	
VENABLE LLP			ROWAN, KURT C	
P.O. BOX 34385			ART UNIT	
WASHINGTON, DC 20043-9998			PAPER NUMBER	
			3643	
DATE MAILED: 09/12/2006				

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/719,063  
Filing Date: November 24, 2003  
Appellant(s): NELSON, DAVID W.

**MAILED**

SEP 12 2006

**GROUP 3600**

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Andrew Aiken  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 19, 2006 appealing from the Office action mailed March 23, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

See US 6651379.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

European 0 367 539	SHERMAN	09.05.1990
4,052,811	SHUSTER et al.	10/1977

"POST-IT" Brand Notes, undated

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 9, 11, 12, and 18 are rejected under 35 USC 102 as being anticipated by Hughes.

Claims 1-3 and 12 are rejected under 35 USC 102 as being anticipated by "Post-It" Brand notes.

Claims 2-3, 5-6, 7-8, 10, and 17 are rejected under 35 USC 103 as being obvious in view of Hughes.

Claims 13, 14, 15, and 16 are rejected under 35 USC 103 as being obvious over Hughes in view of Sherman '539.

Claims 19-20 are rejected under 35 USC 103 as being obvious over Hughes in view of Sherman '539 and Shuster.

#### **(10) Response to Argument**

Applicant argues that in both the patent to Hughes and the "Post-It" brand notes that the paper is not compressible such that when a force is applied a concave depression is formed. Fig. 4 of Hughes shows a pest being folded into a concave depression which conforms to the shape of the insect (disclosed by Hughes in line 16 of column 1). Applicant argues that in Hughes the pest is not embedded within the substrate, but with the substrate covering and surrounding the pest, inherently the pest

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is embedded in the substrate. Applicant is referring to Fig. 15 of the present invention, but it appears that the same thing would happen in Hughes, since clearly a compressible force is being applied by Hughes in Fig. 4 to wrap-up the rodent. In reference to Hughes not being compressible and the examiner has argued that all materials are compressible to some extent. However, it seems like when pressure or force from the rear surface in engagement with an insect will compress the substrate to some extent. Applicant speculates that in Hughes may serve to primarily compress and squash the insect and that the collapse in response to engagement with an insect is not an inherent feature of the sheet. In all likelihood, some elements of both are taking place when a user wraps-up a pest since the amount of force applied depends on the user. The same rational applies to "Post-It" Brand notes. While paper is compressed during manufacture, it still has the ability to collapse in response to a force being applied. To show this point, push down on the edge of "Post-It" note pad with a finger nail and clearly the paper collapses in response to the force. In reference to claim 4, Hughes shows a rigid backing such as foundation sheet 12. Applicant further states that the last adhesive sheet of Hughes and the backing being close to what is recited in claim 1. However, the examiner will leave the operability of this to the applicant. In regard to Hughes not accurately defining a "substrate", it should be pointed out that when a sheet is coated with an adhesive, the sheet acts as a substrate. Applicant appears to attempt to limit the scope of the term substrate, perhaps well beyond the "broadest reasonable interpretation" of the term. In the combination of Hughes having a base sheet and another sheet with an adhesive coating on, the substrate would

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reasonably be considered to be the base layer which in this case would be layer 12. As to Sherman '539, this patent is merely cited to show discontinuous adhesive layers such as strips 124 in Fig. 10 which are used to mount the trap. The whole point being why use more adhesive than is required which would apply to not only the back of the trap but the front of the trap as well and since this type of arrangement lends itself to being a one use and dispose deal, there is clearly motivation to reduce the cost and by limiting the amount of adhesive applied this would occur. As the device is used, one would try to get the adhesive on the pest which would still be possible even with the amount of adhesive found on the edge of a "Post-It" brand note since the adhesive layer is still wider than most insects or would cover a majority of the insect's body. The combination of Hughes in view of Sherman '539 does not attempt to do more than that. In regard to applicant's discussion on hydrophilic materials and that the adhesive blocks the transmission of a liquid, it should be pointed out that applicant has not substantiated this statement with evidence noting that there are both waterproof and non-waterproof adhesives. In response to applicant's argument that there is no suggestion to combine the references, namely Hughes and Sherman, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in

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the art. Applicant argues that the combination would result in a poison feature, but this is clearly not the case since Hughes shows the device functioning without any poison being employed. Applicant's arguments with respect to Shuster have been noted.


**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kurt Rowan

  
KURT ROWAN  
PRIMARY EXAMINER  
GROUP 3200

Conferees:

Peter Poon 

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